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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/906,493	08/05/1997	WILLIAM T. FREEMAN	MERL-1163	6957

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EXAMINER

LE, VU

ART UNIT

PAPER NUMBER

2613

DATE MAILED: 05/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Advisory Action

Application No.

08/906,493

Applicant(s)

Freeman et al.

Examiner

Vu Le

Art Unit

2613



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Apr 15, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
  - (b) ☐ they raise the issue of new matter. (See NOTE below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

4. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see Attachment
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: 37 and 39  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1-21, 32-36, 38, and 40-45
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☐ Other: \_\_\_\_\_

VU LE  
PRIMARY EXAMINER  
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**Attachment to Advisory Action:**

The amendment after final filed April 14, 2002 will be entered. Claims 37 and 39 have been rewritten in independent forms, therefore, they are allowed. The rest of claims 1-21, 32-36, 38, 40-45 are finally rejected (see Paper No. 19).

Applicant's introduction of the dictionary meaning of the word "resolution" is noted. however, Examiner finds this approach as "muddling" the issues. Importantly, Examiner is more concerned that each word in a claim is given its broadest reasonable interpretation consistent with the specification (emphasis added). MPEP § 2111.01. Since Applicant is entitled to be his/her own lexicographer in drafting claim language, a defined word in a claim even though has a literal "dictionary" meaning does not always imply whether such word is consistent with what the specification discloses. Examiner does not go about contemplating if a word in a claim meets the dictionary meaning. When Applicant attempts to provide what the dictionary meaning of a word in a claim means, he/she effectively renders the specification insignificant in defining what the word really means.

Applicant reasserts the argument that the amendment made in the prior response filed on September 28, 2001 (Paper No. 18) to claims 1-2, 7, 15, 19 and 44 are made solely for clarification and not to overcome any rejection. Examiner refutes this argument for the following reasons.

It is viewed that "data" and "image data" are not the same. When applicant amended the word "data" to "image data" in independent claims 1, 15 and 44, it is viewed that applicant did not

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do so simply for "clarification" as asserted, but for the purpose of overcoming the prior art reference to Coiner. Applicant's arguments on page 6, 2nd ¶ of Amendment filed September 28, 2001 (Paper No. 18) reinforces this. In the amendment, applicant argues that "nowhere in the reference text does Coiner discuss or in anyway disclose his data to be image data" (emphasis added). Examiner reads this as an attempt to overcome the prior art reference to Coiner because clearly Coiner does not teach "image data". Furthermore, independent claims 1, 15 and 44 did not recite "image data" until after Coiner was applied in the prior art rejection. For the sake of argument, even assuming that changing the word "data" to "image data" is simply for clarification as stated by the applicant, the word "resolution" would have led one skilled in the art to conclude that the word "data" would inherently or impliedly (by dictionary definition) mean image data. If this is true, then what difference does it make whether to change the word "data" to "image data"? Thus, by amending independent claims 1, 15 and 44 to reflect "image data". Applicant has recognized that Coiner fails to teach this more narrow limitation. Thus, the amendment to claims 1, 15 and 44 to reflect image data would have rendered the grounds for rejection based on Coiner moot.

Applicant laments that prosecution has been lengthy without reaching a "clear issue". It is regrettable that prosecution has taken this long without fruitful result. However, the lack of a "clear issue" as asserted is refuted. The fact that Applicant amended around the Coiner reference shows that Applicant understands what some of the issues are. Furthermore, Examiner did identify in the last Office Action (Paper No. 19) what are allowable subject matters, and Applicant

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responded positively to that. Therefore, there is no lack of a clear issue as asserted. With respect to lengthy prosecution history, again, it is regrettable, but to suggest that this is a result of the lack of "cooperation of the Examiner" is unwarranted. Granted, Examiner did reopened prosecution after Applicant filed the Appeal Brief (Paper No. 16). This action was the result of Applicant's persuasive arguments presented in the Brief, not because Examiner was being uncooperative. Even when Examiner reopened prosecution and introduced new grounds of rejection (Paper No. 17), Applicant was reminded and had ample opportunity to choose (see ¶1 of Office Action, Paper No. 17) whether to reply to this new ground under 37 CFR 1.111 or to request reinstatement of the appeal under 37 CFR 1.193(b)(2). Applicant chose the former and submitted an amendment (Paper No. 18) in response to the new grounds of rejection. Thus, this contributes to a longer than customary prosecution of a case. However, the length of patent prosecution is not a measure of patentability.

For the rest of the arguments presented, they have been previously considered.

If Applicant wishes to expedite prosecution of this application, then it is recommended that Applicant pursues claimed subject matter that is consistent with what has been identified as patentable over the prior art of record.

  
VU LE  
PRIMARY EXAMINER